

REMARKS

Introduction

Status of claims

Claims 1, 4, and 6 are pending in the application.

Claims 1, 4, and 6 have been rejected.

Claim 1 has been currently amended.

Claim 4 has been cancelled

Amendments to Claims

Claim 1 has been amended by inserting the choice of acid group-containing monomers of page 2, last paragraph starting with "Preferably, the acid group-containing monomers ...", lines 5 to 7, deleting the extra period in line 30, and by correcting to "alcohols having" in line 32. Claim 1 has further been amended by defining the polyesters B as being obtained by polycondensation of monomers B1 and B2, and also introducing the limitations for the number of carbon atoms as set out in page 4, second paragraph. Claim 4 has been cancelled.

It is deemed that no new matter has been added by such amendments. It is also deemed that no further search or consideration will be necessitated by this amendment as there is only a restriction fully based on the specification, and entry thereof is therefore respectfully requested.

The Office Action

Claims 1, 4, and 6 have been rejected under 35 U. S. C. 103 (a) as being unpatentable over the the Staritzbichler et al. reference, EP 0 272 524 A2, in view of Tuemmler et al., US 6,114,434. The applicant respectfully traverses this rejection.

The Staritzbichler reference discloses a process to prepare a water-dilutable binder which is a partial condensation product of an addition product (A) of maleic acid or its anhydride and an unsaturated oil or fatty acid, and one or more hydroxy-functional resins which are water-insoluble. The one or more hydroxy-functional resins comprise a mass fraction of at least 30 % of fatty acid-modified polycondensation or polyaddition products (B) which have at least 0.5 mol / kg of a substituted urea group, and also, urethane groups, and which have an acid number of less than 5 mg KOH / g and a Staudinger index ("limiting viscosity number") of from 8 ml/g to 13 ml/g, and up to a mass fraction of 70 % of polyhydroxyl compounds (C) which correspond to the definition of (B) with the exception of the presence of substituted urea groups. The addition product (A) has a mole fraction of preferably from 10 % to 30 % of maleic acid or its anhydride. The components (A), (B) and (C) are condensed at a temperature of from 90 °C to 150 °C up to a Staudinger index of from 10 ml/g to 20 ml/g, in a way that the ratio of the values of the Staudinger index of the polyhydroxyl components to that of the polycarboxyl components is between 1.4 and 2.7, and that the condensation product has at least 0.3 mol of substituted urea groups. See page 1, lines 28 to 48.

As the Examiner has correctly stated in paragraph no. 6 of the Office Action, the Staritzbichler reference does not disclose the mandatory presence of monomers A2 in the acid component according to the present invention; in fact, it does not even mention them anywhere as being useful for the invention taught in Staritzbichler. On the other hand, the acid component A of the present invention as fully defined in claim 1 does not read on the acid components described in the Staritzbichler reference as these mandatorily comprise urethane groups.

The Tuemmler reference discloses condensation products of aldehyde or ketone resins **B** having a hydroxyl number of from 10 mg/g to 350 mg/g, preferably, 20 mg/g to 300 mg/g, (col. 2, lines 3-10) and of acid functional components **A** selected from the group consisting of polyesters, dimerised or oligomerised unsaturated aliphatic carboxylic acids, and polymers of olefinically unsaturated monomers, each having an acid number of from 30 mg/g to 270 mg/g (col. 1, lines 60-67).

The hydroxyl group-containing polyesters **B** of the present invention do not have anything in common with the ketone or aldehyde resins of Tuemmler.

A statement that modifications of the prior art to meet the claimed invention would have been "obvious to one of ordinary skill in the art at the time the invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See MPEP § 2143.01 IV. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Furthermore, the Examiner cannot selectively pick and choose from the disclosed parameters without proper motivation as to a particular selection. The mere fact that a reference may be modified to reflect features of the claimed invention does not make the modification, and hence the claimed invention, obvious unless the prior art suggested the desirability of such modification. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). Thus, it is impermissible to simply engage in a hindsight reconstruction of the claimed invention where the reference itself provides no teaching as to why the applicant's

combination would have been obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

The acid group-containing components A of the Staritzbichler reference (addition products of maleic acid or its anhydride to unsaturated oils or fatty acids) and the acid group-containing components of the Tuemmler reference are entirely different, as are also the hydroxyl group-containing components B of Staritzbichler which must have urethane groups while the hydroxy group-containing component of Tuemmler is an aldehyde or ketone resin.

Therefore, not only is there no teaching, suggestion or motivation to combine the teachings of the cited references, there is also no reasonable expectation for a person of ordinary skill in the art that such combination would possible solve a new problem. And even if such combination would have been made, this would and could not have led to the present invention.

Accordingly, the person of ordinary skill in the art would not and could not combine these references to arrive at the subject matter of the present invention. For the above reasons, this rejection should be withdrawn.

In view of the above response, applicant believes the pending application is in condition for allowance.

Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03 2775, under Order No. 32007 00018 US from which the undersigned is authorized to draw.

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Respectfully submitted,

Electronic signature

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